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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,618	08/05/2003	Joseph S. Bowers JR.	13064US02	6586

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EXAMINER

KUGEL, TIMOTHY J

ART UNIT PAPER NUMBER

1712

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



<b>Office Action Summary</b>	Application No. 10/634,618	Applicant(s) BOWERS ET AL.	
	Examiner Timothy J. Kugel	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |



### **DETAILED ACTION**

1. Claims 1-18 are pending as amended on 30 December 2005. Claims 11-17 are withdrawn from consideration.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

3. Applicant's election with traverse of the invention of claims 1-10 and 18 in the reply filed on 30 December 2005 is acknowledged. The traversal is on the grounds that no different field of search is shown and that the mode of operation is the same. This is not found persuasive because the different fields of search was shown in the previous Office action (class 516 subclass 38 for the invention of the elected claims 1-10 and 18, and class 422 subclass 41 for the invention of the non-elected claims 11-17) and the modes of reducing alkalinity and of isolating from a reactive atmosphere are different.

The requirement is still deemed proper and is therefore made **FINAL**.

4. This application contains claims 11-17 drawn to an invention nonelected with traverse in the response filed 30 December 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Specification***

5. Applicant's amendment, filed 30 December 2005, with respect to updating the reference to the parent application and the correction of Tradenames has been fully considered and are corrective.



The objection to the specification has been withdrawn.

***Double Patenting***

6. Applicant's terminal disclaimer, filed 30 December 2005, has been fully considered and is proper.

The rejection of claims 1-10 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 12-14 of US Patent 6,623,787 (Bowers hereinafter) has been withdrawn.

***Claim Rejections - 35 USC § 102 and 35 USC § 103***

7. The rejection of claims 1-9 under 35 USC 102(b) as being anticipated by US Patent 5,476,580 (Thorn hereinafter) is maintained.

8. The rejection of claim 10 under 35 USC 103(a) as being unpatentable over Thorn in view of US Patent 5,718,746 (Nagasawa hereinafter) is maintained.

9. The rejection of claim 18 under 35 USC 103(a) as being unpatentable over Thorn is maintained.

Applicant's arguments filed 30 December 2005 have been fully considered but they are not persuasive.

Applicant argues that Thorn fails to disclose all of the limitations of claim 1 because Thorn teaches the addition of sodium bicarbonate, which would increase the ionic strength of the dispersion, which is taught away from in the instant specification; however, the instant claims do not require a method that does not increase the ionic strength of the dispersion. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.



Applicant further argues that Thorn does not teach or suggest a viscosity-unstable aqueous dispersion of carbon that is susceptible to viscosity increase during use or having a conductivity of less than 3 mS, and challenging the examiner's position—that since Thorn teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the viscosity-instability and susceptibility to viscosity increase of the Thorn composition would inherently be the same as claimed—as an assertion of Official Notice. While Thorne may not teach the viscosity-unstable dispersion applicant discloses in the specification, Thorne does indeed teach a composition that fully embraces the composition of the instant claims and therefore a rejection asserting the inherency of the function, property or characteristic of the composition is proper. Again, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Applicant further argues that Thorne fails to teach a viscosity of less than 20 cps. This is so, but—as stated in the previous Office action—it would have been obvious to a person of ordinary skill in the art to reduce the viscosity of the Thorn composition to less than 20 cps for the purpose of improving the flow of the dispersion, since it has been held that that discovering an optimum value of a result effective variable involves only ordinary skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA).

Applicant finally argues that Nagasawa fails to teach ammonia in an amount sufficient to make the dispersion susceptible to a viscosity increase during use; however, Nagasawa does indeed teach a dispersion comprising ammonia that fully



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embraces the composition of instant claim 10 and it would be obvious to perform the method of Thorn using the composition of Nagasawa for the motivation of to allow the dispersion to be used over a long period of time as shown by Nagasawa.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday-Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJK  
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